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EXAMINER

RANGREJ, SHEETAL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/652,849

**Applicant(s)**

SHORT, DOUGLAS J.

**Examiner**

Sheetal R. Rangrej

**Art Unit**

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/29/2003 and 12/30/2003</u> . | 6) <input type="checkbox"/> Other: ____  |

### ***Prosecution History Summary***

- Claims 1-20 are pending.

### ***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4, 6-15, 17-19, and 21-23 of copending Application No. 11/326763. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Priority***

- The applicant receives the priority of the provisional application 60/486846.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 10-14 are directed to a state governed full-insured health insurance policy, i.e. printed matter. When printed matter is not functionally related to a substrate, the printed matter may be construed as a mere arrangement of data, though seemingly a "product," data is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. *Claims 1-2, 8, 10-11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reference U in view of Reference V.*

6. As per claim 1, Reference U teaches providing a state-governed fully-insured health insurance policy to a group of employees as a non-taxed compensation to an

Art Unit: 3626

employee, but as a tax deductible expense to the employer (U: page 1, paragraph 1, lines 5-10 and paragraph 3, lines 1-3).

Reference U does not teach conditioning a benefit under a policy for an employee to participation in a voluntary wellness program.

Reference V teaches conditioning a benefit under the policy for the employee to participation in a voluntary wellness program (page 2, paragraph 5, lines 1-11).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference U's and V's teachings. One of ordinary skill would have been motivated to combine these teachings because Reference V teaches that "it was developed by the Insurance committee in response to the increasing medical costs and premiums" (page 2, paragraph 4, lines 1-2).

7. As per claim 2, the method of claim 1 is as described above.

Reference U does not teach said wellness program includes a wellness category that includes at least one of a tobacco free category, a normal blood pressure category, a non-overweight category and a regular exercise category.

Reference V teaches said wellness program includes a wellness category that includes at least one of a tobacco free category, a normal blood pressure category, a non-overweight category (body-mass index) and a regular exercise category (personal wellness profile) (V: Strategies: page 3, lines 6-7 and 15-17). In light of the

Art Unit: 3626

specification, the examiner interprets that having these screenings is the same as providing associated wellness categories to employees.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference U's and V's teachings. One of ordinary skill would have been motivated to combine these teachings because Reference V teaches "that purposes of the Wellness Program is influencing district personnel and their family members to move from simply contemplating health issues to assisted preparation, action, and then continued maintenance of positive health behaviors" (V: page 1, paragraph 2, lines 5-8).

8. As per claim 8, the method of claim 1 is as described above.

Reference U does not teach wherein said wellness program includes at least one of wellness education

Reference V teaches wherein said wellness program includes at least one of wellness education (V: page 3, paragraph 1, lines 15-17).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference U's and V's teachings. One of ordinary skill would have been motivated to combine these teachings because Reference V teaches that it "encourages district personnel and their families to strengthen their health and well-being through educational opportunities..." (V: page 1, paragraph 2, lines 2-4).

Art Unit: 3626

9. As per claim 10, Reference U teaches a state-governed fully-insured health insurance policy to a group of employees that is a tax deductible expense to the employer while being non-taxed compensation to an employee (U: page 1, paragraph 1, lines 5-10 and paragraph 3, lines 1-3).

Reference U does not teach at least one conditional benefit under a policy for the employee being conditioned on a voluntary participation in at least a portion of a wellness program.

Reference V teaches at least one conditional benefit under a policy for the employee being conditioned on a voluntary participation in at least a portion of a wellness program (page 2, paragraph 5, lines 1-11).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference U's and V's teachings. One of ordinary skill would have been motivated to combine these teachings because Reference V teaches that "it was developed by the Insurance committee in response to the increasing medical costs and premiums" (page 2, paragraph 4, lines 1-2).

10. As per claim 11, the method of claim 10 is as described above.

Reference U does not teach said wellness program includes a wellness category that includes at least one of a tobacco free category, a normal blood pressure category, a non-overweight category and a regular exercise category.

Reference V teaches said wellness program includes a wellness category that includes at least one of a tobacco free category, a normal blood pressure category, a non-overweight category (body mass index) and a regular exercise category (personal wellness profiles) (V: Strategies: page 3, lines 6-7 and 15-17).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference U's and V's teachings. One of ordinary skill would have been motivated to combine these teachings because Reference V teaches "that purposes of the Wellness Program is influencing district personnel and their family members to move from simply contemplating health issues to assisted preparation, action, and then continued maintenance of positive health behaviors" (V: page 1, lines 7-10).

11. As per claim 13, the method of claim 10 is as described above.

Reference U does not teach wherein said wellness program includes at least one of wellness education.

Reference V teaches wherein said wellness program includes at least one of wellness education (V: page 3, paragraph 1, lines 15-17).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference U's and V's teachings. One of ordinary skill would have been motivated to combine these teachings because Reference V teaches that it "encourages district personnel and their families to



Art Unit: 3626

strengthen their health and well-being through educational opportunities..." (V: page 1, paragraph 2, lines 2-4).

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reference U in view of Reference V and further in view of Reference E.

13. As per claim 9, the method of claim 1 is as described above.

References U and V do not teach a step of providing employees with opportunities to at least one of improve and monitor their wellness condition.

Reference E teaches a step of providing employees with opportunities to at least one of improve and monitor their wellness condition (E: column 10, lines 5-12).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference U in view of V's teachings with Reference E. One of ordinary skill would have been motivated to combine these teachings because Reference E discloses, "problems can be solved by exploring their origins. Then and only then can guidelines be established for possible prevention" (E: column 1, lines 35-38).

14. Claims 3, 4, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reference U in view of Reference V, as applied to claim 2 above, and further in view of Reference A and Reference B.

15. As per claim 3, the method of claim 2 is as described above.

Reference U and V do not teach providing an ERISA governed health insurance policy to employees as a non-taxed benefit to an employee, but as a tax-deductible

Art Unit: 3626

expense; and structuring the state-governed fully-insured health insurance policy to cover a healthcare expense not covered by ERISA governed health insurance policy.

Reference A teaches providing an ERISA governed health insurance policy to employees as a non-taxed benefit to an employee, but as a tax-deductible expense (Ryan: column 3, lines 29-35).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference U in view of V with Reference A's teachings. One of ordinary skill would have been motivated to combine teachings because Reference V teaches that "it was developed by the Insurance committee in response to the increasing medical costs and premiums" (V: page 2, paragraph 4, lines 1-2).

Reference U, V, and A do not teach structuring the state-governed fully-insured health insurance policy to cover a healthcare expense not covered by ERISA governed health insurance policy.

Reference B teaches structuring the state-governed fully-insured health insurance policy to cover a healthcare expense not covered by ERISA governed health insurance policy (B: column 6, lines 39-40). In light of the specification, the examiner interprets "primary insurance policy" to be the same as ERISA governed health insurance policy and "secondary insurance coverage" to be the same as state-governed fully-insured health insurance policy.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference U in view of V and Reference A with Reference B's teachings. One of ordinary skill would have been motivated to combine teachings because Reference B teaches that "it is to provide a secure system that converges...multiple types of information including but not limited to payment options for patient co-pay portion of a procedure, patient insurance benefit information, and third party co-pay information" (B: column 4, lines 18-23).

16. As per claim 4, the method of claim 3 is as described above.

Reference U teaches a conditional benefit under the state-governed fully-insured health insurance policy includes coverage for at least a portion of a claim falling within a deductible for the ERISA governed health insurance policy (U: page 2, paragraph 1, lines 1-4).

17. As per claim 14, the method of claim 10 is as described above.

Reference U and V do not teach an ERISA governed health insurance policy for the plurality of employees that is a companion to the state-governed fully-insured health insurance policy; and a conditional benefit under the state-governed fully-insured health insurance policy covering a healthcare expense not covered by ERISA governed health insurance policy.

Reference A teaches an ERISA governed health insurance policy for the plurality of employees that is a companion to the state-governed fully-insured health insurance policy (A: column 3, lines 29-35).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference U in view of V with Reference A's teachings. One of ordinary skill would have been motivated to combine teachings because Reference V teaches that "it was developed by the Insurance committee in response to the increasing medical costs and premiums" (V: page 2, paragraph 4, lines 1-2).

Reference U, V, and A do not teach a conditional benefit under the state-governed fully-insured health insurance policy covering a healthcare expense not covered by ERISA governed health insurance policy.

Reference B teaches a conditional benefit under the state-governed fully-insured health insurance policy covering a healthcare expense not covered by ERISA governed health insurance policy (B: column 6, lines 39-40). In light of the specification, the examiner interprets "primary insurance policy" to be the same as ERISA governed health insurance policy and "secondary insurance coverage" to be the same as state-governed fully-insured health insurance policy.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference U in view of Reference V and Reference A with Reference B's teachings. One of ordinary skill would have been motivated to combine teachings because Reference B teaches that "it is to provide a secure system that converges...multiple types of information including but not

Art Unit: 3626

limited to payment options for patient co-pay portion of a procedure, patient insurance benefit information, and third party co-pay information" (B: column 4, lines 18-23).

18. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reference U in view of Reference V, as applied to claim 2 above, and further in view of Reference C.

19. As per claim 5, the method of claim 2 is as described above.

Reference V does not teach increasing a deductible on the ERISA governed health insurance policy relative to a previously provided ERISA governed health insurance policy and making a conditional benefit under the state-governed fully-insured health insurance policy cover at least a portion of the deductible increase.

Reference U teaches making a conditional benefit under the state-governed fully-insured health insurance policy cover at least a portion of the deductible increase (U: page 2, paragraph 2, lines 1-5).

Reference U does not teach increasing a deductible on the ERISA governed health insurance policy relative to a previously provided ERISA governed health insurance policy.

Reference C teaches increasing a deductible on the ERISA governed health insurance policy relative to a previously provided ERISA governed health insurance policy (C: page 2, paragraph 0013, lines 3-5; page 2, paragraph 0014, lines 4-8; page 6, paragraph 0070, lines 2-5). The examiner interprets inclusion of the "request element" to be the same as increasing a deductible on the insurance policy.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference U in view of Reference V with Reference C's teachings. One of ordinary skill would have been motivated to combine teachings because Reference C teaches that "insurance coverage is often subjected to local legislation and rules, necessitating that each state essentially be considered a different market place" (C: page 1, paragraph 0005, lines 9-15).

20. Claims 6-7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reference U in view of Reference V, as applied to claim 1 above, and further in view of Reference D and Reference E.

21. As per claim 6, the method of claim 1 is as described above.

Reference U and E do not teach said wellness program includes at least one illness screening and said step of conditioning a benefit includes a step of conditioning coverage for at least a portion of an identified illness to employee participation in an illness screening for the identified illness.

Reference V teaches said wellness program includes at least one illness screening (D: page 2, lines 7-8).

Reference V does not teach said step of conditioning a benefit includes a step of conditioning coverage for at least a portion of an identified illness to employee participation in an illness screening for the identified illness.

Reference D teaches said step of conditioning a benefit includes a step of conditioning coverage for at least a portion of an identified illness to employee

Art Unit: 3626

participation in an illness screening for the identified illness (D: page 3, paragraph 0050, lines 1-4). In light of the specification, the examiner interprets the pharmaceutical benefit plan coverage to be the same as coverage for at least a portion of an identified illness.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference U in view of V with Reference D's teachings. One of ordinary skill would have been motivated to combine teachings because Reference E teaches "that major dysfunctions and diseases leading to catastrophic conditions, early aging, serious illness and even death could have been prevented had they been identified before the appearance of devastating symptoms" (E: column 1, lines 23-27) and "because health care costs are a priority for every business, large or small. It is essential that employers seek a cost effective health care plan" (E: column 1, lines 50-52).

22. As per claim 7, the method of claim 6 is as described above.

Reference U, D, and E do not teach an identified illness includes at least one of cancer, heart disease, abnormal vision, abnormal orality, and mental illness; and Said at least one illness screening includes a cancer screen, a heart disease screen, an abnormal vision screen, an abnormal orality screen and a mental illness screen.

Reference V teaches an identified illness includes at least one of cancer, heart disease, abnormal vision, abnormal orality, and mental illness; and said at least one illness screening includes a cancer screen, a heart disease screen, an abnormal vision

Art Unit: 3626

screen, an abnormal orality screen and a mental illness screen (V: page 2, lines 7-8).

The examiner interprets that if a screening for an illness is done and if it comes back as a positive result, then the illness has been identified.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference U in view of V.

One of ordinary skill would have been motivated to combine teachings because Reference E teaches that "major dysfunctions and diseases leading to catastrophic conditions, early aging, serious illness and even death could have been prevented had they been identified before the appearance of devastating symptoms" (E: column 1, lines 23-27).

23. As per claim 12, the method of claim 10 is as described above.

Reference U and E do not teach said wellness program includes at least one illness screening for at least one identified illness and said conditional benefit includes at least partial coverage for said identified illness.

Reference V teaches said wellness program includes at least one illness screening for at least one identified illness (D: page 2, lines 7-8).

Reference V does not teach said conditional benefit includes at least partial coverage for said identified illness.

Reference D teaches said conditional benefit includes at least partial coverage for said identified illness (D: page 3, paragraph 0050, lines 1-4). In light of the



Art Unit: 3626

specification, the examiner interprets the pharmaceutical benefit plan coverage to be the same as coverage for at least a portion of an identified illness.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference U in view of V with Reference D's teachings. One of ordinary skill would have been motivated to combine teachings because Reference E teaches "that major dysfunctions and diseases leading to catastrophic conditions, early aging, serious illness and even death could have been prevented had they been identified before the appearance of devastating symptoms" (E: column 1, lines 23-27) and "because health care costs are a priority for every business, large or small. It is essential that employers seek a cost effective health care plan" (E: column 1, lines 50-52).

24. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reference G in view of Reference F.

25. As per claim 15, Reference G and F teach a method of administering a health plan for a group of employees, comprising the steps of:

Reference G teaches determining whether a conditional benefit under a state-governed fully-insured health insurance policy is available to an employee making a claim at least in part by determining whether the employee is a participant in a voluntary wellness program (G: column 1, lines 58-67).

Reference G does not teach processing the claim with respect to the state-governed fully-insured health insurance policy if the conditional benefit is available to the employee

Reference F teaches processing the claim with respect to the state-governed fully-insured health insurance policy if the conditional benefit is available to the employee (F: page 20, paragraph 0218, lines 21-24). In light of the specification, the examiner interprets the ability to impact the claims values means the ability to process the claim was accomplished. The examiner also interprets that in order for the claim to be filed, an employee must have insurance, thus the claim is processed with respect to the state-governed fully-insured health insurance policy based on the conditional benefit (wellness program).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference G's teachings with Reference F's teachings. One of ordinary skill would have been motivated to combine these teachings because Reference F teaches that it will "have an overall positive impact upon the claims values within the employer group" (F: page 20, paragraph 0218, lines 21-24).

26. As per claim 16, the method of claim 15 is as described above.

Reference G does not teach processing the claim with respect to an ERISA governed health insurance policy that is a companion to the state-governed fully-insured health insurance policy.

Art Unit: 3626

Reference F further teaches processing the claim with respect to an ERISA governed health insurance policy that is a companion to the state-governed fully-insured health insurance policy (F: page 20, paragraph 0218, lines 21-24). In light of the specification, the examiner interprets the ability to impact the claims values means the ability to process the claim was accomplished. The examiner also interprets that all insurance policies are ERISA governed health insurance policy.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference G's teachings in with Reference F's teachings. One of ordinary skill would have been motivated to combine these teachings because Reference F teaches that it will "have an overall positive impact upon the claims values within the employer group" (F: page 20, paragraph 0218, lines 21-24).

27. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reference G in view of Reference F as applied to claim 15 above, and further in view of Reference U.

28. As per claim 17, the method of claim 16 is as described below.

References G and F do not teach applying the claim to a deductible under the ERISA governed health insurance policy and paying at least a portion of the claim under state-governed fully-insured health insurance policy.

Reference U teaches:

- a. Applying the claim to a deductible under the ERISA governed health insurance policy (U: page 1, paragraph 2, lines 3-7). The examiner interprets the ability to have a claim account to be the same as having an insurance policy; and
- b. Paying at least a portion of the claim under state-governed fully-insured health insurance policy (U: page 2, paragraph 1, lines 1-4).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference G in view of F with Reference U's teachings. One of ordinary skill would have been motivated to combine these teachings because Reference F teaches that it will "have an overall positive impact upon the claims values within the employer group" (F: page 20, paragraph 0218, lines 21-24).

29. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reference G in view of Reference F as applied to claim 15 above, and further in view of Reference U and Reference V.

30. As per claim 18, the method of claim 15 is as described above.

References G and F do not teach a step of paying at least a portion of the claim if the employee was a member of at least one of said wellness categories before incurring the claim; and wellness program includes a wellness category that includes at least one of a tobacco free category, a normal blood pressure category, a non-overweight category and a regular exercise category.

Art Unit: 3626

Reference U teaches a step of paying at least a portion of the claim if the employee was a member of at least one of said wellness categories before incurring the claim (U: page 2, paragraph 1, lines 1-4).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference G in view of Reference F with Reference U's teachings. One of ordinary skill would have been motivated to combine these teachings because Reference F teaches that it will "have an overall positive impact upon the claims values within the employer group" (F: page 20, paragraph 0218, lines 21-24).

References G, F, and U do not teach said wellness program includes a wellness category that includes at least one of a tobacco free category, a normal blood pressure category, a non-overweight category and a regular exercise category.

Reference V teaches said wellness program includes a wellness category that includes at least one of a tobacco free category, a normal blood pressure category, a non-overweight category and a regular exercise category (V: Strategies: page 3, lines 6-7 and 15-17).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference G in view of Reference F and Reference U with Reference V's teachings. One of ordinary skill would have been motivated to combine these teachings because Reference V teaches "that purposes of the Wellness Program is influencing district personnel and their family

Art Unit: 3626

members to move from simply contemplating health issues to assisted preparation, action, and then continued maintenance of positive health behaviors" (V: page 1, lines 7-10).

31. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reference G in view of Reference F and further in view of Reference V in view of Reference E.

32. As per claim 19, the method of claim 15 is as described above.

References G and E do not teach said wellness program includes an illness screening for at least one identified illness; and said determining step includes a step of determining if the claim is based at least in part on said identified illness and whether the employee participated in an illness screening for said identified illness before incurring the claim.

Reference V teaches said wellness program includes an illness screening for at least one identified illness (V: page 3, lines 7-8).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference G in view of F with Reference V's teachings. One of ordinary skill would have been motivated to combine teachings because Reference E teaches "that major dysfunctions and diseases leading to catastrophic conditions, early aging, serious illness and even death could have been prevented had they been identified before the appearance of devastating symptoms" (E: column 1, lines 23-27) and "because health care costs are a priority for every

Art Unit: 3626

business, large or small. It is essential that employers seek a cost effective health care plan" (E: column 1, lines 50-52).

Reference G, V, and E do not teach said determining step includes a step of determining if the claim is based at least in part on said identified illness and whether the employee participated in an illness screening for said identified illness before incurring the claim.

Reference F teaches said determining step includes a step of determining if the claim is based at least in part on said identified illness and whether the employee participated in an illness screening for said identified illness before incurring the claim (F: page 20, paragraph 0218, lines 1-24). In light of the specification, the examiner interprets that in order to identify cardiac disease, a screening was done, and the claim costs are based on that screening with in conjunction with the physician, thus the employee participated in a screening before incurring the claim.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference G in view of F and Reference V with Reference F's teachings. One of ordinary skill would have been motivated to combine teachings because Reference E teaches, "more than 50% of health care costs are lifestyle-related and therefore preventable. Individual consumers interested in optimal health and fitness need to identify specific areas of personal improvement. Responsible managers in business need to develop systems to manage

Art Unit: 3626

the optimal health of their employees, not only to save costs but to also save lives" (E: column 9, lines 20-27).

33. Claims 20 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Reference G in view of Reference F and further in view of Reference E and Reference V.

34. As per claim 20, the method of claim 15 is as described below.

References G and F do not teach said wellness program includes at least one of wellness education; and said determining step includes a step of determining whether the employee participated in at least one of wellness education before incurring the claim.

Reference E teaches said wellness program includes at least one of wellness education (E: column 11, lines 17-22); and said determining step includes a step of determining whether the employee participated in at least one of wellness education before incurring the claim (E: column 9, lines 46-54). In light of the specification, the examiner interprets that if the deductible is decreased than the claims submitted will also be decreased because of employee's awareness from a wellness education will send him/her less to the doctor, thus less claim filing.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined Reference G in view of Reference F with Reference E's teachings. One of ordinary skill would have been motivated to combine teachings because Reference V teaches that it "encourages



Art Unit: 3626

district personnel and their families to strengthen their health and well-being through educational opportunities..." (V: page 1, paragraph 2, lines 2-4).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheetal R. Rangrej whose telephone number is 571-270-1368. The examiner can normally be reached on 5/4/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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SRR

  
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